

REMARKS

Claims 1-3, 5-21 and 28-29 are pending in the instant application upon entry of this Amendment.

Claims 22-27 have been canceled without prejudice to the filing of one or more divisional applications directed to the subject matter thereof.

Claims 1 and 12-13 have been amended to be directed to those embodiments of Applicants' invention wherein the optically active organic acid comprises one of, or is selected from the group consisting of, (+)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine, (-)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine, and non-racemic mixtures thereof. Claim 21 has been amended to be directed to those embodiments of Applicants' invention wherein the diastereoisomeric salts are based on (+)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine or (-)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine. Support for the amendments made herein to claims 1, 12-13 and 21 can be found throughout the Specification, for example, at paragraph numbers [0028], [0036], [0038]-[0039], and in Example 3. Claim 14 has been amended to place it in independent form, incorporating all elements of original claim 1 from which it originally depended. Claim 5 has been amended to depend from claim 14, rather than claim 1. New claim 28 depends from amended claim 1 and is supported in the Specification, for example, at paragraph [0038] and [0039]. New claim 29 is directed to the subject matter of original claim 14 and is supported as such. No new matter has been added by the amendments made herein. Additionally, the amendments made herein do not necessitate additional claims fees. A complete listing of all claims ever presented in accordance with 37 C.F.R. §1.121(c)(1) is contained herein. Accordingly, entry of the amendments made herein is proper and respectfully requested.

In the Office Action, the Examiner rejects claims 1-5, 7-12 and 21 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent Application Publication No. 2003/0109752 of Hoorn, *et al.* ("Hoorn"). Additionally, the Examiner rejects claims 1-5, 7-12 and 21 under 35 U.S.C. §102(b), as being anticipated by Czech Republic Patent No. 290708 ("the Czech patent"). In each instance, the Examiner contends that the reference discloses the resolution of tamsulosin by using camphor sulfonic acids in alcoholic media followed by crystallization and recrystallization.

Additionally, the Examiner rejects claims 1-13 and 21 under 35 U.S.C. §103(a), as being unpatentable over the combined teachings of Hoorn and the Czech patent. The Examiner contends that Hoorn discloses examples of the reaction being carried out in organic solvents, water or mixtures thereof. The Examiner contends that the Czech patent adds further examples. However, the Examiner acknowledges that the claimed invention differs from the

disclosure of the references "in that not all possible solvents and reaction conditions are exemplified." (See, the Office Action, page 3). The Examiner argues that it would have been obvious at the time the invention was made to one of ordinary skill in the art to use additional solvents, temperatures and reactions times with the expectation of producing resolved tamsulosin enantiomers.

Applicants respectfully traverse each of the Examiner's rejections and the arguments and contentions set forth in support thereof for the following reasons.

One embodiment of Applicants' claimed invention is directed to processes for separating the R(-) and the S(+) enantiomers of the claimed benzenesulfonamide compound. As amended, this embodiment of Applicants' claimed invention requires placing a mixture of the R(-) and S(+) enantiomers in contact with an optically active organic acid selected from the group consisting of (-)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine, (+)-N-(3,5-dinitrobenzoyl)- α -phenyl-glycine, and non-racemic mixtures thereof.

Neither Hoorn nor the Czech patent disclose the use of the claimed glycines in any manner. Accordingly, Applicants respectfully submit that neither Hoorn nor the Czech patent anticipates claims 1-3, 5-13 and 21, as amended. Moreover, with respect to claims 14-20, Applicants respectfully note that in the Office Action, the Examiner indicated that claims 14-20, while objected to, would be allowable, if rewritten in independent form. It is respectfully submitted that claim 14 has been amended to be in independent form containing the entirety of claim 1 from which it originally depended. Thus, claims 14-20 are allowable and unobjectionable.

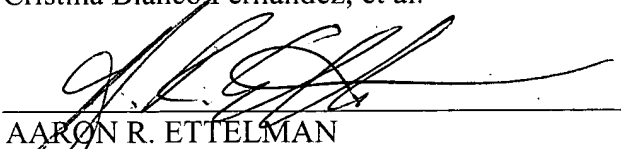
With respect to the Examiner's rejection under §103(a) on the basis of the combined teachings of Hoorn and Czech patent, Applicants respectfully submit that neither reference cures the deficiencies of the other. Neither Hoorn nor the Czech patent discloses or suggests the use of the claimed glycine organic acids for the separation of the claimed benzenesulfonamide enantiomers. Finally, neither reference contains any teaching or suggestion whatsoever which would motivate one of ordinary skill in the art to replace the camphor sulfonic acids disclosed in Hoorn and the Czech patent with the claimed glycines. Accordingly, Applicants respectfully submit that neither Hoorn, the Czech patent or a combination thereof is sufficient to establish a *prima facie* case of obviousness with respect to the claims in the instant application.

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Reply to Office Action of March 30, 2005

In view of the amendments made herein and the remarks set forth above,
Applicants respectfully submit that all pending claims patentably distinguish over the prior art of
record and known to Applicants. Accordingly, entry of this Amendment, reconsideration,
withdrawal of the rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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(Date)

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Enclosure – Petition for Extension of Time (three months)